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HILTON EXAMINER

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ART UNIT	PAPER NUMBER
3307	5

DATE MAILED: 09/11/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on \_\_\_\_\_  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.  \_\_\_\_\_

**Part II SUMMARY OF ACTION**

1.  Claims 1 - 3, 6-8, 12, 13, 37, 38, 40, 42-48, 50, 51, 63-75 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 4, 5, 7-11, 14-36, 39, 41, 49, 52-62 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1 - 3, 6-8, 12, 13, 37, 38, 40, 42-48, 50, 51, 63-75 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

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**Part III DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 1, 2, 43, 47, 50, 63, 64, 65 and 69 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 1, line 4, "members" is vague and indefinite. The use of --member-- is suggested. Further in claim 1, lines 6, 8, 12 and 13 "alloy member(s)" is vague and indefinite. The use of --at least one alloy member-- is suggested.

Regarding claim 2, line 3, "the shape memory alloy member(s) is vague and indefinite. The use of --at least one alloy member-- is suggested.

With respect to claim 43, lines 1-2, "the loop" and "drawstring means" lack proper antecedent basis.

In claim 47, line 2; claim 50, line 5 and 7; the use of "or" is vague and indefinite.

Regarding claim 63, lines 1-2, "the elastically deformable member(s)" lacks proper antecedent basis. Further in claim 63, "inteded" appears to be a typographical error.

In claim 64, "the elastic member(s)" lacks proper antecedent basis. Further in line 3, the use of "preferably" is vague and indefinite.

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With respect to claim 65, line 1, "the elastic member(s)" lacks proper antecedent basis.

2. The above are merely examples of the indefiniteness and as such are not considered a comprehensive listing. Review and correction of the claims is necessary.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. **Claims 1-3, 6-8, 12, 13, 37, 38, 40, 42-48, 50, 51 and 63-75 are rejected under 35 U.S.C. § 103 as being unpatentable over Demeter in view of Dulebohn.**

Demeter teaches the use of surgical device/pouch (figure 1) having a bag/barrier/sheet (19), actuating means that automatically opens the bag (as broadly claimed; column 6, line

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62 et seq.), hollow housing (17) and handles (column 5, lines 48-54).

Dulebohn teaches the use of a surgical device that uses a shape memory material (nitinol; column 5, lines 60-66).

It would have been obvious to modify the surgical device taught by Demeter to include the material type taught by Dulebohn so that the device may be more elastic and stronger.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Specifically, United States Patents to Wilk and Down show the use of similar devices.

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to John Hilten at telephone number **(703) 308-0719**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-0858**.

JSH  
August 31, 1995



**John S. Hilten**  
Patent Examiner  
Group 3300